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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,011

Applicant(s)

MEYER ET AL.

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-100 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 41-100 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 85-93 and 95 are objected to because of the following informalities: The subject claims contain functional recitation e.g. “transmits said data ...” that has not given patentable weight because it is narrative in form. In order to be patentable weight, a functional recitation must be expressed as a “means” (or equivalent) for performing the specified function, as set forth in 35 USC §112, 6th paragraph, and must be supported by recitation in claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

3. Claims 81-92 and 97 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because:

Claims 81-92 and 97 are not within technological arts and

Claims 81-92 and 97 recite within their scope a human being.

2.1 The claimed invention does not fall within the technological arts because no form of technology is claimed (limitations “at least one payor”, “at least one payee”, “a payment system” are broadly interpreted as being manual means of affecting a payment from a payor to a

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payee). The applicant's are referred to recent ruling by the US Patent and Trade Mark Office, Board of Appeals and Interferences (Ex Parte Bowman, 61 USPQ2d 1669) (Unpublished)).

2.2 The claims recite within its scope a human being (payor and payee). Per Commissioner Quigg's notice published at 1077 OG 24 (April 21, 1987), "a claim directed to or including within its scope a human being will not be considered to be a patentable subject matter under 35 U.S. C. 101"

Specification

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims (refer to claims 81-92). The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'g denied (Fed. Cir. July 8, 1991) and reh'g, en banc, denied (Fed. Cir. July 29, 1991).

Claims 81-92 include the limitation "payment system ... and subsequently, to simultaneously transmit funds to said payee ...". However, the specification does not provide an enabling disclosure to support the claimed payment system that enable transmitting funds

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(electronic equivalent thereof such as electronic credit voucher etc.) simultaneously to the payee with receipt of a payment from a payor) as recited in each of claims 81-92.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 81-92 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 81-92 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 41-46 and 49 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Powar (US-PAT-NO: 6438527) (hereafter Powar).

Claim 41: Powar discloses a bill payment system comprising:

a biller generating at least one invoice for at least one customer, said invoice comprising:

a unique bar code, said bar code comprising data identifying at least said customer and said biller (Fig. 5 step 51 and Fig. 3 shows invoice with claimed data described in col. 4 L 42-58);

a scanning apparatus configured to scan said bar code, said scanning apparatus being capable, based on the identifying data of said bar code, and a payment made by said customer, of concurrently transmitting funds to said biller in a predetermined amount and transmitting data to said biller regarding said payment (universal data capture means shown in Figure 4, in particular optical reader 400 and magnetic strip reader 402 performs the claimed functions). Claim 42.

wherein said funds are transmitted as an electronic funds transfer(step S7 of Fig.5 refer to electronic bill payment order and col. 6 L 27-35 for details of funds transfer)

Claim 43. wherein said funds are transmitted via the Automated Clearing House (col. 6 L 30-34, payment network 208).

Claim 44. wherein said bar code comprises a plurality of validation levels (col. 6 L 7-18, the data is validated at several levels).

Claim 45. wherein said data comprises the date and time said customer makes said payment (col. 4 L 23-30, since data capture replaces a remittance stub, this feature is inherent).

Claim 46. A method according to claim 51, wherein said scanning is performed at a point-of-sale system (col. 6 L 3-6, here the integrated telephone is equivalent to a point of sale (POS) system).

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Claim 49. data identifying said biller is assigned by a central registry authority (inherent because the biller B and C-B account number may present the bill an electronic statement presentment (ESP) system which would assign the biller identification number to conform to its own protocol).

Claim 93 said biller applies said payment made by said customer against said invoice as of said date and time said customer makes said payment (Powar col. 4 L 32-41, ..applies credit to consumer C's account..).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 46-48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powar.

Claim 46-48. Powar or Remington fail to disclose that the apparatus is integrated into a point-of-sale per claim 46 (note that Powar teaches integrating that the apparatus may be built into an integrated telephone which is equivalent to a POS considering the breadth of the claim as discussed before in 102(e) rejection), location of scanning system or method per claim 47 and

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location of the bar code in the invoice per claim 48. However it has been generally recognized that location where the process is performed (making portable, integral, separable etc.) would be within the level of ordinary skill in the art. In re Lindberg, 93 U.S.P.Q. 23; In re Larson et al., 144 U.S.P.Q. 347; In re Dulberg, 129 U.S.P.Q. 348; In re Stevens, 101 U.S.P.Q. 284.

Claim 50. Powar or Remington fail to disclose the that the method comprise printing a receipt evidencing said payment.

Official is notice is taken that printing receipt of payment at the location of payment is old and well known business practice. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement printing a receipt for the payment since it would serve as a proof of payment and other records as deemed necessary by the customer.

Claims 56-60 have been analyzed per corresponding system claims 46-50 respectively.

12. Claims 51-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powar as applied to claim 41 above, and further in view of Thomas et al. (US Pat. 6,317,745).

Powar fails to disclose payment system (and corresponding method) as permitting a third party to carry out scanning the bar code and subsequently affecting payment as recited in the instant claims. However, it is noted that Powar discloses all functionality of bill payment as claimed notwithstanding employment of a third party or third parties to carry out the bill payment.

However, bill payment methods and systems thereof are well known wherein third parties carries out process for affecting bill payment on behalf of a plurality of bill payors and a plurality of billers as disclosed by Thomas et al. (Thomas et al. Abstract and col. 35 L 36 – col. 6 L 6).

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It would have been obvious to one of ordinary skill in the art at the time of invention to have one or more third party to carry out the bill payment based on bar coded data and subsequently to affect the bill payment via electronic funds transfer as per combination of Powar and Thomas, because this would alleviate need of having the scanning equipment at the customer's premise and thus simplify the bill payment process.

Claims 52-60 and 94 are analyzed as per corresponding system claims 42-50 and 93.

13. Claims 51-80, 94-96 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powar as applied to claim 41 above, and further in view of Remington et al. (US Pat. 6,070,150) (hereafter Remington).

Claim 51 Powar teaches scanning the bar code based on the identifying data of said bar code and a payment made by said customer, to concurrently transmit funds to said biller in a predetermined amount and transmit data to said biller regarding said payment as per analysis of claim 41.

Powar fails to teach that a third party (on behalf of a payor) performs the scanning of the bar code and perform transmittal of funds as recited herein.

Remington, in the same field of endeavor, however, Remington teaches a bill payment method where a third party (intermediary) is permitted to process the bill payment in response to payments received from the customers (col. 16 L 14-34, this arrangement shown in Fig. 11).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to combine methods of Powar and Remington that would permit a third party (intermediary) to utilize the method of bill payment disclosed by Powar such that the third party based on the identifying data of said bar code and a payment made by said customer, would concurrently transmit funds to the biller in a predetermined amount and transmit data to said biller regarding said payment, because the resulting method would (a) improve accuracy of data entry and processing by way of correctly capturing payment data (bar code) (b) reduce bill presentment, remittance and settlement that reduces bill delivery and remittance processing expenses and (c) improve cash flow and fund predictability.

Claims 52-60 and 94 are analyzed as per corresponding system claims 42-60 and 93 respectively.

Claim 98 analyzed per claim 51.

14. Claim 61 is analyzed as discussed in claim 51 with the clarification that Remington bill payment method is applicable to a plurality of billers and a plurality of consumers as one of ordinary skill in the art would appreciate. Therefore, discussion of claim 51 as presented earlier also applies to claim 61.

Claims 62-70 and 95 are analyzed as per corresponding system claims 42-60 and 93 respectively.

15. Claim 71. Powar discloses a bill payment method comprising:

receiving an invoice from a biller, said invoice comprising a unique bar code, said bar code comprising data identifying at least a customer and said biller (Powar Fig. 5 step S1, it includes BRN and C-B numbers); and

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[permitting a third party in communication with said biller] to scan said bar code and, based on the identifying data of said bar code and a payment made by said customer, to concurrently transmit funds to said biller in a predetermined amount and transmit data to said biller regarding said payment (universal data capture means shown in Figure 4, in particular optical reader 400 and magnetic strip reader 402 performs the claimed functions)

Powar fails to disclose payment system (and corresponding method) as permitting a third party to carry out scanning the bar code and subsequently affecting payment as recited in the instant claims. However, it is noted that Powar discloses all functionality of bill payment as claimed notwithstanding employment of a third party or third parties to carry out the bill payment.

Remington, in the same field of endeavor, however, Remington teaches a bill payment method where a third party (intermediary) is permitted to process the bill payment in response to payments received from the customers (col. 16 L 14-34, this arrangement shown in Fig. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine methods of Powar and Remington that would permit a third party (intermediary) to utilize the method of bill payment disclosed by Powar such that the third party based on the identifying data of said bar code and a payment made by said customer, would concurrently transmit funds to the biller in a predetermined amount and transmit data to said biller regarding said payment, because the resulting method would (a) improve accuracy of data entry and processing by way of correctly capturing payment data (bar code) (b) reduce bill presentment,

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remittance and settlement that reduces bill delivery and remittance processing expenses and (c) improve cash flow and fund predictability.

All limitations of claims 72-80 and 96 have been analyzed as in claims 42-50 and 93 respectively.

16. Claims 81-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen et al. (US Pat. 6,289, 322) (Kitchen) and further in view of Comer et al. (US Pat. 5,596,501) (Comer).

Claim 81. Kitchen teaches a payment network at least comprising:

one payor (refer to Fig. 1, Payor station 120a-d);

at least one payee maintaining an account corresponding to said payor (refer to Fig. 1, Biller station 110a-d);;

a payment system adapted first to receive a payment from said payor, and subsequently, to simultaneously transmit funds to said payee in a predetermined amount based on said payment and transmit data to said payee regarding said payment (Fig. 2, bill processing network, col. 6 L 29-49, refer also to col. 8 L 56- end for further details);

wherein said payee credits said account corresponding to said payor in the amount of said payment (inherent in process described at col. 9 L 15-29, where a message indicating the amount of payment remitted and associated payor account number is transmitted) as of said date and time said payment system receives said payment from said payor (refer to col. 8 L 56- end, "the processor 410, responsive to the received payment instruction ... directs the payment of applicable bills by electronic funds transfer..).

Kitchen fails to recite data including the date and time said payment system received said payment from said payor. However, it is asserted that maintaining record of date and time for payment (i.e. time stamp) is old and common practice within the skill of one ordinary skill in the art. Comer, for example, in the same field of endeavor, teaches payment data having date and time which are included with payment data. It would have been obvious to one of ordinary skill in the art at the time of the invention to include date and time of the receipt of the payment by the system per claim 81, because this data provides proof of timely payment of the bill to the payees for their record keeping.

Claim 82-84. All limitations have been analyzed in a similar manner as discussed in claim 81 analysis.

Claim 85, 86, 87 and 88: said payment system transmits said data and said funds to said payee in said predetermined amount on the same calendar or business day or next calendar or business day following the date said payment system receives said payment from said payor, or within 24 hours or less of the date and time said payment system receives said payment from said payor (col. 8, L 56-67, payment instructions generated by the payor processor 450 which is processed by the processor 410 of CF station 140 Note: no patentable weight given to function, refer to claim objections).

Claims 89-92: wherein said payment system identifies the payee said payor is paying by scanning a bar code comprising information corresponding to said payee

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(payment instructions as recited at col. 8, L 56-67, Note: no patentable weight given to “scanning” function, refer to claim objections).

17. Claims 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powar and further in view of Comer et al. (US Pat. 5,596,501) (Comer)

Claim 97. Powar teaches a payment system comprising:

a payor (Consumer Fig. 1);

a payee furnishing said payor with a unique bar code, said bar code comprising data identifying at least said payor and said payee (Biller B); and

a scanning apparatus configured to scan said bar code, said scanning apparatus being capable, based on the identifying data of said bar code and a payment made by said payor, of electronically transmitting to said payee both funds in a predetermined amount (Fig. 4, Universal Data Capture means, col. 4-5).

Powar fails to recite data including the date and time said payment system received said payment from said payor. However, it is asserted that maintaining record of date and time for payment (i.e. time stamp) is old and common practice within the skill of one ordinary skill in the art. Comer, for example, in the same field of endeavor, teaches payment data having date and time which are included with payment data. It would have been obvious to one of ordinary skill in the art at the time of the invention to include date and time of the

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receipt of the payment by the system per claim 81, because this data provides proof of timely payment of the bill to the payees for their record keeping.

18. Claim 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen and further in view of Powar

Claim 99. Kitchen teaches method of providing for payment of bills by payors to billers, comprising:

making available to one or more billers a standard format for representing on a printed document data including biller identification and payor account identification (Kitchen, col. 6 L 50-58, normalizing billing information by CF station 140);

providing information to a payment network to effect transmission of funds from an account of said third party to an account of one of said billers identified by said biller identification in an amount identified by said payment amount and concurrently effecting transmission of payment information to said biller (Kitchen, payment instructions, col. 8 L 56-67).

providing at one or more locations of one or more third parties one or more scanning apparatus adapted to read data in said standard format (CF station, Fig. 2) is a third party);

Kitchen fails to teach providing the CF station location with a scanning apparatus as claimed and receiving by electronic transmission from one of said scanning apparatus data comprising third party identification, biller identification, payor account identification and payment amount .

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However, Powar, in the same filed of endeavor, teaches receiving by electronic transmission from one of said scanning apparatus data comprising third party identification, biller identification, payor account identification and payment amount (payor is also a third party, refer to discussion of claims 41 etc.).

It would have been obvious to one of ordinary skill in the art at the time of invention to provide the scanning apparatus as recited in Powar adapted to read data in the standard format as disclosed by Powar to CF station location to carry out the claimed method of providing for bills by payors to billers because, locating the scanning devices at third party locations (such as retail stores, banks etc.) would provide convenient method of making their bill payments in manner to similar to ATM machines for banking.

19. Claim 100 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen and Powar and further in view of Comer et al. (US Pat. 5,596,501) (Comer).

Claim 100. Kitchen and Kitchen fail to recite that payment information comprises the date and time said payment is made. However, it is asserted that maintaining record of date and time for payment (i.e. time stamp) is old and common practice within the skill of one ordinary skill in the art. Comer, for example, in the same field of endeavor, teaches payment data having date and time which are included with payment data. It would have been obvious to one of ordinary skill in the art at the time of the invention to include date and time of the receipt of the payment by the system per claim 81, because this data provides proof of timely payment of the bill to the payees for their record keeping.

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Conclusion

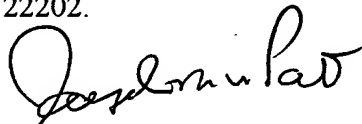
20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114.

Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

December 10, 2002